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EXAMINER

IRSHADULLAH, M

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/187,749

Applicant(s)

UTSUMI ET AL.

Examiner

M. Irshadullah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 09 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 09, 2002 has been entered.

2. This communication is in response to the amendments filed August 09, 2002.

### ***Summary Of Instant Office Action***

3. Applicant's arguments, filed August 09, 2002, concerning claims 1-8 rejections, para 4, Office Action, Paper No. 16, remailed April 12, 2002 have been considered, deemed unpersuasive and the prior rejection is maintained.

4. Applicant's amendments, filed June 19, 2002, to claim 1 have been entered.

5. New claim 9 has been entered and is under prosecution in Office Action set out below.

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al ( US Patent 5,553,139 ) in view of Hasebe et al ( US Patent 5,392,351 ).

Ross et al disclose:

**Claim 1.** A license devolution apparatus ( Title and col 1, lines 7-8 )

a) accessing a first storage medium storing contents encrypted with a predetermined key ( Col 1, line 56, recited with lines 52-53, Fig. 6B described col 1, lines 46-51, Fig. 5 ( Enabler Keys ), Fig. 2 ( 210, 216, 218 ) recited with col 6, lines 1-3, 8-13, 16 and 19-20. It needs be mentioned that the use of a predetermined (enabler) key or a key generated during encryption process are notoriously known in the art under discussion ), a first media ID identifying the first storage medium ( Please see discussion below ), and a first encryption secure information generated by encrypting the key and a first use information, representing a right to use the contents, together with one another or individually, with the first media ID, and accessing a second storage medium, storing a second media ID identifying the second storage medium (

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Please see discussion below ), wherein the right of using the contents stored in said first storage medium is devolved from said first storage medium to said second storage medium ( Col 6, line 49, col 1, lines 51-54 read with lines 37-38 ( application/content of first media/CD and by the same token another application program/content relating to second media/diskette), and col. 3, line 6-8 (specifically line **7-transferring (devolving)**) read with col 6, lines 40-49 together with lines 52-54 ), yet

Ross et al do not show:

a first media ID, identifying the first storage medium,  
(storing) a second media ID identifying the second storage media.

However, Hasebe et al teach the same ( Fig. 2 (12) described col 2, lines 9-12, col 9, lines 1-9 ).

It would have been obvious to one of ordinary skill in the license/information protection/securing art at the time of applicant's invention to include media IDs in Ross et al's invention, because it would provide additional/enhanced protection to electronic data/information in addition to copyright protection.

said license devolution apparatus comprising:

b) decoding means for decoding the first encryption secure information stored in said first storage medium using the first media ID to obtain the key and the first use information ( Ross et al: Col 4, lines 22-24, col 6, lines 40-59 ( specifically line 49, 52-56 ), col 7, lines 28-40, 47-55, Fig 4 described col 7, lines 56-65 continue col 8, lines 5-8, and Fig. 7 ( C, D, E ), and discussion about media ID in 1a) above ); and

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c) encryption means for encrypting the key and a second use information, representing a second right to use the contents that is devolved from the first storage medium to the second storage medium together with one another or individually with the second media ID, to generate a second encryption secure information for storage in said second storage medium (Ross et al: Fig 2 (210, 218), Fig. 5 (A, B), col 3, lines 17-24, col 6, lines 40-49 and 51-52 recited with col 4, lines 8-15, col 3, lines 34-45 and col 7, lines 32-55, and discussion about media ID in 1a above).

**Claim 2.** A license devolution apparatus according to claim 1, wherein said encryption means encrypts with the first media ID a third use information, obtained through subtracting the second use information from a first use information, or encrypts with the first media ID both the key and the third right of using, to generate a third secure information and stores the third encryption secure information in the first storage medium ( Ross et al: Fig. 2 ( 210, 218 ), Fig 5 ( A, B ), Fig. 5 ( any of 2-4 would be considered as third user of the third right of using and obtained by eliminating/subtracting the second right of using from the first right of using ) and col 3, lines 40-45, and discussion about media ID above ).

**Claim 3.** A license devolution apparatus according to claim 1, wherein if the entire rights of using the contents, to which the first storage medium is entitled, are devolved to the second storage medium ( Claim 1, lines 37-41, col 4, lines 8-15 and col 6-col 7(up to line 20 ) ), the first encryption secure information stored in the first storage medium is destroyed ( Ross et

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al: Fig. 1 ( 102 ), col 4, lines 16-18. Applicant will appreciate that reference's disabling function/process would be used to disable/erase/delete/destroy the secure information stored in the first storage medium after transferring the information to another/second etc. media ).

**Claim 4.** A license devolution apparatus according to claim 1, wherein before devolution of the right to use the contents, the first storage medium stores contents whose right to use is intended to be devolved as encrypted contents ( Figs. 6A and 6B described col 1, lines 31-61 ), and

wherein said license devolution apparatus further comprises contents transfer means for reading the encrypted contents from the first storage medium, and storing in the second storage medium the read encrypted contents ( Claim 1, lines 37-41. Reading devices, like diskette or CD drives are inherently implied ).

**Claim 5.** A license devolution apparatus according to claim 2, wherein the first use information and the second use information represent the presence of the right to use, and the third use information represents the absence of the right to use ( Fig. 5, any of 2-4 would be a first (user) of first use information, a second (user) of second use of information and when two are using the use information, third one ( say, installer ) would be unable/absent to have the right of using the use information unless the use information is transferred/distributed/devolved simultaneously to all ).

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**Claim 6.** A license devolution apparatus according to claim 2, wherein the first use information represents of a first available number of times or available time, the second use information is represents a second available number of times or available time which is less than the first available number of times or available time, and the third use information represents a third available number of times or available time which is obtained through subtracting the second available number of times or available time from the first available number of times or available time ( Inherent, since the user under the agreement would be obliged to use the product ( document, picture or program ) for certain number of time(s) and when one user would transfer/devolve the right of use, he could only do so for the remainder of one's available number of times ).

**Claim 7.** A license devolution apparatus according to claim 1, further comprising a first drive and a second drive driving the first storage medium and the second storage medium, respectively, said first drive and said second drive having a first firmware and a second firmware accessing the first storage medium and the second storage medium, respectively ( Inherent, since the diskette or CD or other media drives have their respective drivers or softwares/firmwares for running the same ),

wherein said decoding means and said encryption means are arranged in a firmware consisting of said first firmware and said second firmware in form of a composite unit; and wherein only said first firmware has authority to access the first storage medium driven by said



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first drive, and only said second firmware has authority to access the second storage medium driven by said second drive ( Inherent, since each driver ( software/firmware ) would be able ( have authority ) to run its respective media having an ID and access the information on it ).

In the following claim Ross et al show: “ a predetermined key (Fig. 5 ( Enabler Key ) ”, and do not explicitly show “ storing in storage media ”.

**Claim 8.** A license devolution method, comprising:

However, Hasebe et al teach the following except above mentioned “ predetermined key ”:

a) storing in a first storage medium contents encrypted with a predetermined key, a first media ID identifying the first storage medium, and encryption secure information generated by encrypting with the first media ID, the key and a first use information, which represents a right to use the contents ( Fig. 4 ( s3, s6, s7 ) described col 6, lines 3-43, Fig. 2 ( 12, 13, 14 ), col 4, lines 10-15. Col 5, lines 3-7 ).

“Storing” in computer art is notoriously known. It would have been obvious to one of ordinary skill in the art at time of instant invention to advantageously use the available technique, because it would save time and money which would be spent on R&D.

Following steps are method steps of apparatus claim above, same rationale applies as to elements claim 1(a) and 1 (b) above.

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b) decoding the first encryption secure information using the first media ID to obtain the key and first use information;

c) generating a second encryption secure information by encrypting with a second media ID, which identifies a second storage medium, the key and second use information, which represents a second right to use the contents that is devolved from the first storage medium to the second storage medium; and

storing the second encryption secure information in said second storage medium, wherein the right to use the contents stored in the first storage medium is devolved from the first storage medium to the second storage medium (Hasebe et al: Fig. 4 (s3, s6, s7), col 6, lines 3-43 read with col 4, lines 62-64, col 9, lines 6-9 and motivation statement under Applicant's claim 1a) above ).

**Claim 9.** (NEW) A license devolution system in communication with computer readable storages (Ross et al: Col. 2, lines 41-44 recited with lines 1-7 and col. 3, lines 6-11 (specifically lines 6-8, reciting: The present invention employs a scheme for creating, extracting, **transferring (devolving)**, enforcing and managing electronic licenses)), comprising:

a) an access unit accessing a first storage unit having a first storage ID and storing contents encrypted with a predetermined key and storing a first encryption secure information generated by encrypting the key and a first use information, which represents a right to use the contents, with the first storage ID, and accessing a second storage unit having a second storage

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ID identifying the second storage unit (See the discussion of Applicant's claim 1a) above.

Applicant will appreciate that reference's accessing function clearly points to the presence of "an access unit" in the system);

b) a decoder decoding the first encryption secure information stored in said first storage unit using the first storage ID to obtain the key and the first use information (See the discussion of Applicant's claim 1b) above); and

c) a devolving unit devolving the right to use the contents of the first storage unit to the second storage unit by generating a second use information, which represents a second right to use the contents devolved from the first storage unit to the second storage unit, and encrypting the key and the second use information with the second storage ID to generate a second encryption secure information stored in said second storage unit. Applicant will appreciably realize that reference's "transferring function-col. 3, line 7", clearly shows the presence of a transferring (devolving) unit. Moreover, reference's encryption function (Col. 3, lines 15-16) clearly directs to the presence of encryption unit which would be used as a devolving unit as per Applicant's Remarks, last lines under NEW CLAIM which read: The "devolving unit" of new claim 9 **can** correspond to encryption means 22 in Fig. 1.

### ***Response to Arguments***

7. Applicant's arguments filed August 09, 2002 have been fully considered, but the same are not persuasive.

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Applicant argues:

a) Page 2, lines 7-10: “devolved” as defined in the dictionary means “transference of rights to another and/or degeneration of rights”. In this regard, Applicant is referred to Ross et al’s col. 3, lines 6-7 and claim 1, lines 37-38, wherein the license(s) is/are being transferred (devolved) so that the user or enduser (Col. 2, lines 29-34) is enabled to use the product and contents thereon.

b) Page 2, lines 13-16: “The Examiner acknowledges that Merriam Webster’s Collegiate Dictionary defines the term “License/Licence as to give permission or consent to (use something, such as a storage medium, CD, Diskette etc., including contents thereon/therein). However, the definition does not mention the word “transfer”. In this respect Applicant will appreciate that Ross et al show “transfer” (Col. 3, line 7 and claim 1, line 39). The dictionary definition of License/Licence as “to give permission or consent to (use something)” clearly indicates “granting of right(s)” to some one to use something.

c) Page 2, lines 21-25: “the IEEE dictionary is limited to the standard terms used by IEEE association and its definition of “license” as “A legal agreement between two parties, the licensor and the licensee, as to terms and conditions for the use or transfer of intellectual property right from the licensor to the licensee” is not well known, understood/employed sense in the relevant art. Applicant ought to appreciate that IEEE is a globally known organization and its words or terms are considered authentic in the “electrical and electronic” art and believably Applicant

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belongs to the art. Moreover, the dictionary under consideration is known, used and practiced in all non-patent literary circles as authentic so will be the term "license".

d) Page 2, lines 26-28: "words "devolution and "license" in Clack's Law Dictionary, 6th ed. 1990 do not overlap and are nor synonymous". Applicant is referred to the dictionary's page 92, left col which recites License as "The permission by competent authority to do an act which, without such permission, would be illegal, a trespass, a tort, or otherwise not allowable". In other words, competent authority permits (grants the right) to do an act (use some thing, such as CD etc. including the content thereon). It is in this sense and intention cited "grant of permission" becomes synonymous to "devolve" which is defined as "To **pass** or be transferred a (right) from one to another". Further, terms bear meanings when used in proper or appropriate context or art as emphasized or elucidated by the Law Dictionary further: "The term is said to be **peculiarly appropriate** to the passing of an estate from one person dying to a person living".

In support of the fact that "attaching usage rights" to a license which would be a vehicle to transfer the attached rights to use some thing and "devolving" or "devolution" of rights are old, well known and practiced in the art under discussion, applicant is referred to Stefik's col. 11, lines 64-67 and col. 44, lines 57-67 and Pinard et al's Col. 3, lines 19-34. Both the patents are enclosed.

In the light of above mentioned facts , Examiner respectfully states that applicant's arguments have been fully considered, deemed unpersuasive and the rejections under prior Office Action, Paper No. 16, remailed April 12, 2002 are maintained.

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***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


A) Stefik, US Patent 5,715,403. System For Controlling The Distribution And Use Of Digital Works Having Attached Usage Rights Are Defined By A Usage Rights Grammar.

B) Pinard et al, US Patent 5,638,494. Adaptive Communication System.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Irshadullah whose telephone number is (703) 308-6683. The examiner can normally be reached on M-F from 11:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax numbers for the organization are (703) 746-7239 and for after Final (703) 746-7238.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.

  
M. Irshadullah

October 24, 2002

  
Susanna Diaz  
Patent Examiner  
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